

REMARKS

Claims 1-20 are pending. This includes independent claims 1, 14 and 18.

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caro et al. '109 and further in view of Mullins '293. Claims 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Penrice '514 and further in view of Caro et al. '109, and further in view of Mullins '293.

A. Claims 14-20

As an initial matter, in regards to the 35 U.S.C. §103(a) rejection of claims 14-20, Applicant submits Penrice '514 is not a proper reference in a §103 rejection in the present application. Penrice '514 only qualifies as prior art under 35 U.S.C. §102(e). However, 35 U.S.C. §103(c)(1) sets forth that a §102(e) reference cannot preclude patentability under §103 when the subject matter of the reference and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. In this case, the present application was subject to an assignment and was assigned to IGT by the sole inventor shortly after filing of the application by way of an assignment executed on October 15, 2003. A copy of the Assignment records from the PTO's website for the present application are attached for the Examiner's reference. Likewise, Penrice '514 was, at the same time assigned by the sole inventor (Penrice) to IGT. A copy of the Assignment records from the PTO's website for the Penrice '514 are also attached for the Examiner's reference.

Thus, Penrice '514 is not a proper reference in a §103(a) rejection of any claim in the present application. Accordingly, the rejection of claims 14-20 is not valid, and applicant respectfully submits that these claims are allowable. Favorable action thereon is respectfully requested.

B. Claims 1-13

In response to Applicant's Appeal Brief filed on August 6, 2008, the Examiner has withdrawn the "Final" status of the rejection, but has essentially reissued the identical rejection. For the reasons set forth in detail in Applicant's Appeal Brief, applicant does not acquiesce in the rejection. However, in order to further prosecution of the application, applicant has amended the independent claims herein so that there can be absolutely no question with respect to the distinctions previously argued and set forth in the claims with respect to Caro '109.

At page 17 of the Office Action, the Examiner states:

Regarding the specific argument by the applicant that Caro et al fails to disclose that the outcome for the instant win game is independent of the base wagering game. The Examiner respectfully disagrees with the applicant. In paragraphs 0045, 0048, 0049, Caro et al discloses an option for the player to play an instant game as well as a future lottery game, wherein the result of the instant game will not have any affect on the future lottery game, thus making the two games independent of each other.

With all due respect, the Examiner has focused solely on the "independent" nature of the base wagering game and the instant win game. However, the Examiner has ignored the explicit limitation in the independent claims that also sets forth that the instant win game is not dependent upon or a function of the first set of game indicia. Respectfully, there is no reasonable interpretation of the claim limitation calling for the instant win game to not be dependent upon or a function of the first set of game indicia

that could possibly read on the game of Caro '109. As previously explained, the very purpose of the game of Caro '109 is to use the same entry in both games so as to allow the player to have "multiple play opportunities with his or her selected set of numbers." (Caro '109, paragraph 0022) Caro '109 expressly states that the purpose for using the same entry for both games is that:

With the same player-selected set of numbers, play is therefore extended, and play value of the game is increased. (Caro '109, paragraph 0049)

So that there can be no question on this matter, applicant has amended independent claim 1 to even more particularly specify the distinctions between the first set of game indicia and the second set of game indicia. In particular, claim 1 calls for the step of separately generating a second set of game indicia that is different from the first set of game indicia for play of the instant win game. The claim further calls for determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia. With all due respect, there is simply no reasonable interpretation of these claim limitations that would encompass a base game and a future game that uses the same set of game indicia, as in the game of Caro '109. Claim 1 calls for separately generating a second set of game indicia that is different from the first set of game indicia, and using the second set of game indicia to determine the outcome of the instant win game. As discussed above and in particular in Applicant's Appeal Brief, Caro '109 emphasizes and explicitly describes that the same set of game indicia is used for play of all of the games.

Independent claims 14 and 18 are amended herein in a manner similar to that set forth above with respect to claim 1, and the distinguishing remarks apply to these independent claims as well.

In the Office Action, the Examiner also stated:

The Examiner would once again iterate that all of the limitations of the submitted claims have been rejected utilizing the combination of Caro et al, Mullins, and Penrice.

With respect to the independent claims, Mullins was cited merely as teaching a lottery game wherein the theme of the instant win game is completely different from the theme of a base game. The Examiner asserted that it would have been obvious to incorporate the lottery game of Caro into the gaming method taught by Mullins "in order to allow players to increase their winnings as well as increasing player's interest in the games by implementing different themes between the base game and the bonus game." Even assuming that this combination were made as suggested by the Examiner, the combination still does not rectify the deficiencies discussed above with respect to the base reference Caro '109. Mullins may teach to have games with different themes, but there is nothing in Mullins '109 that would result in one skilled in the art reconfiguring the game of Caro '109 such that a second set of game indicia is generated, which is different from the first set of game indicia, and used in the instant win game. This is particularly true when considering that the very purpose of Caro '109 is to provide the player with different play opportunities with the same set of game indicia.

Accordingly, applicant respectfully requests the Examiner to reconsider the obviousness rejection of the present claims in view of the base reference Caro '109, and to allow the claims.

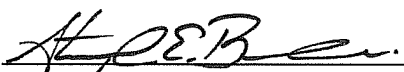
Claims 2 through 13 only further patentably define the method of claim 1, and are allowable for at least the reasons claim 1 is allowable.

As discussed above, claims 14 through 20 are allowable for at least the reasons that Penrice '514 is not a proper reference in the §103 rejection. In addition, independent claims 14 and 18 are amended herein to reflect the distinctions set forth and discussed above with respect to claim 1, and are additionally allowable for at least the reasons that claim is allowable.

With the present Amendment, applicant respectfully submits that all pending claims are allowable, and that the application is in condition for allowance. Favorable action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned at his convenience should he have any questions regarding this matter or require any additional information. Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.

By: 
Stephen E. Bondura
Registration No.: 35,070

P.O. Box 1449
Greenville, SC 29602-1449
(864) 271-1592
Fax (864) 233-7342



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Patent #: [7134959](#) **Issue Dt:** 11/14/2006 **Application #:** 10603539 **Filing Dt:** 06/25/2003

Publication #: [20040266514](#) **Pub Dt:** 12/30/2004

Inventor: Stephen Penrice

Title: METHODS AND APPARATUS FOR PROVIDING A LOTTERY GAME

Assignment: 1

Reel/Frame: [014534/0723](#)

Recorded: 09/29/2003

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: [PENRICE, STEPHEN](#)

Exec Dt: 07/29/2003

Assignee: [IGT](#)

9295 PROTOTYPE DRIVE
RENO, NEVADA 89521

Correspondent: MARSHALL, GERSTEIN & BORUN LLP

AARON M. PETERS
233 S. WACKER DRIVE
SUITE 6300, SEARS TOWER
CHICAGO, IL 60606-6357

Assignment: 2

Reel/Frame: [014920/0502](#)

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Pages: 7

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Exec Dt: 10/22/2003

Assignee: [SCIENTIFIC GAMES ROYALTY CORPORATION](#)

220 CONTINENTAL DRIVE, SUITE 407
NEWARK, DELAWARE 19713

Correspondent: ARNALL GOLDEN GREGORY LLC

LANCE D. REICH, ESQ
1201 WEST PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

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Reel/Frame: [014301/0564](#)

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Assignee: THE BANK OF NEW YORK, AS ADMINISTRATIVE AGENT
ONE WALL STREET
NEW YORK, NEW YORK 10286

Correspondent: SIMPSON THACHER & BARTLETT LLP
JASON A. COHEN, ESQ.
425 LEXINGTON AVENUE
NEW YORK, NY 10017

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Assignee: JP MORGAN CHASE BANK, N.A.
270 PARK AVENUE
NEW YORK, NEW YORK 10017

Correspondent: CBC COMPANIES DBA FEDERAL RESEARCH
1023 FIFTEENTH STREET, NW, STE 401
ATTN: CAREY LENING
WASHINGTON, DC 20005

Assignment: 5

Reel/Frame: 019602/0106

Recorded: 07/24/2007

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Exec Dt: 12/31/2006

Assignee: SCIENTIFIC GAMES INTERNATIONAL, INC.
220 CONTINENTAL DRIVE
SUITE 407
NEWARK, DELAWARE 19713

Correspondent: DORITY & MANNING, P.A.
P.O. BOX 1449
GREENVILLE, SC 29601

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Exec Dt: 06/09/2008

SCIENTIFIC GAMES SA INC.

Exec Dt: 06/09/2008

AUTOTOTE GAMING, INC.

Exec Dt: 06/09/2008

Assignee: JPMORGAN CHASE BANK, N.A., AS ADMINISTRATIVE AGENT

270 PARK AVENUE
NEW YORK, NEW YORK 10017

Correspondent: IP RESEARCH PLUS, INC.
21 TADCASTER CIRCLE
ATTN: PENELOPE J.A. AGODOA
WALDORF, MD 20602

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Total Assignments: 5**Patent #:** NONE**Issue Dt:****Application #:** 10670555 **Filing Dt:** 09/23/2003**Publication #:** 20050064925**Pub Dt:** 03/24/2005**Inventor:** Arthur S. Robb**Title:** Lottery and gaming systems with multi-theme instant win games**Assignment: 1****Reel/Frame:** 014862/0038**Recorded:** 01/08/2004**Pages:** 3**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** ROBB, ARTHUR S.**Exec Dt:** 10/15/2003**Assignee:** IGT, A NEVADA CORPORATION

9295 PROTOTYPE DRIVE

RENO, NEVADA 89521-8986

Correspondent: MARSHALL, GERSTEIN & BORUN LLP

MARTIN J. HIRSCH

6300 SEARS TOWER

233 S. WACKER DRIVE

CHICAGO, IL 60606-6357

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1201 WEST PEACHTREE STREET

SUITE 2800

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Assignment: 3**Reel/Frame:** 017448/0558**Recorded:** 04/11/2006**Pages:** 38**Conveyance:** SECURITY AGREEMENT

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NEW YORK, NEW YORK 10017**Correspondent:** CBC COMPANIES DBA FEDERAL RESEARCH
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ATTN: CAREY LENING
WASHINGTON, DC 20005**Assignment: 4****Reel/Frame:** 019602/0106**Recorded:** 07/24/2007**Pages:** 16**Conveyance:** MERGER (SEE DOCUMENT FOR DETAILS).**Assignor:** SCIENTIFIC GAMES ROYALTY CORPORATION**Exec Dt:** 12/31/2006**Assignee:** SCIENTIFIC GAMES INTERNATIONAL, INC.
220 CONTINENTAL DRIVE
SUITE 407
NEWARK, DELAWARE 19713**Correspondent:** DORITY & MANNING, P.A.
P.O. BOX 1449
GREENVILLE, SC 29601**Assignment: 5****Reel/Frame:** 021281/0001**Recorded:** 07/23/2008**Pages:** 30**Conveyance:** SECURITY AGREEMENT**Assignors:** SCIENTIFIC GAMES INTERNATIONAL, INC.**Exec Dt:** 06/09/2008

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270 PARK AVENUE
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